

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

I. Status of the Claims

Claims 1-11, 14-18, 22, and 24-26 are pending in this application.¹ Claims 1-3 were amended to further clarify the invention. Support for amendments can be found, for example, in paragraphs [93] to [97]. Accordingly, no new matter has been introduced into the application as a result of the present amendments.

II. Claim rejection under 35 U.S.C. § 112, first paragraph (Written Description)

The Examiner rejected claims 1-11, 14-18, 22, and 24-26 as allegedly failing to provide support for a “single admixed reagent,” stating that the specification supports providing a luciferase-luciferin component and a transferase-quenching component separately and then mixing the two components together just prior to use to form a reagent composition. Applicants respectfully traverse this rejection.

It is axiomatic that sufficient written description is required under 35 U.S.C. §112, first paragraph to inform a skilled artisan that Applicants were in possession of the claimed invention at the time of filing. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 94 (Fed. Cir. 1986). The specification provides sufficient written description of the claimed invention in view of the disclosure therein and what was known in the art at the time of filing. Claims 1 to 3, as amended, are directed to methods for measuring ATP-dependent transferase enzymatic activity, for screening a compound for its effect on ATP-dependent transferase enzymatic activity, and for high throughput screening. *See* the specification, for instance, at paragraphs [0042] to [0156], including Examples 1-8 which describe measuring ATP-dependent transferase enzymatic activity and screening compounds for its effect on ATP-dependent transferase enzymatic activity.

The Examiner’s requirement to incorporate additional reagent composition preparation steps into the claims appears to be driven by the Examiner’s concern that the reagent composition is unstable and must be prepared just prior to use. However, the

¹ In the instant Office action, the Examiner states that claims 1-18, 22, and 24-26 were examined. However, claims 12 and 13 were cancelled in previous responses to Office actions. *See, e.g.,* the response filed on July 1, 2008.

Examiner's concern is misplaced, particularly in light of the detailed teachings in the specification. For instance, the specification teaches that the stability of the reagent composition is such that it allows for multiple analyses of sample(s) over extended periods of time, including four hours or more. See the specification, for instance, at paragraphs [0024] and [0087]. While the specification does teach combining two separate components to prepare a reagent composition in a preferred embodiment, the specification also teaches methods involving the addition of a reagent composition to samples without a requirement that two separate components be prepared and combined to make the reagent composition. See the specification, for instance, at paragraphs [0022], [0044], and [0059]. Therefore, the Examiner's requirement of including claim limitations directed to additional method steps of preparing a reagent composition from two separate components is not only unnecessary, it is also improper in light of the broad teachings of the specification.

In view of the present amendments and discussion above, the Applicants respectfully submit that the rejection of claims 1-11, 14-18, 22, and 24-26 based on section 112, first paragraph, is improper and should be withdrawn.

III. Conclusion

The Applicants believe that the application is ready for allowance. A favorable decision is earnestly solicited. If the Examiner has any question, he is invited to call the undersigned attorney.

Respectfully submitted,

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Brian Linford # 50,494
for Emily Miao
Reg. No. 35,285

McDonnell Boehnen Hulbert & Berghoff, LLP
300 South Wacker Drive
Chicago, IL 60606
Telephone: 312-913-0001
Facsimile: 312-913-0002